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Trademark Law

May 16, 2006

Director of Technology Center 3600
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 3653
Patent Examiner Michael E. Butler

Re: **Appeal Nos.:** 2005-0064 and 2003-1769
Application Serial No.: 09/014,076
Confirmation No.: 4092
Applicants: McGrady, et al.
Title: Method For Tracking And
Dispensing Medical Items
Docket No.: D-1056 DIV3

Sir:

Please find enclosed Petitions pursuant to 37 C.F.R. § 1.181 for filing in the application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with these filings (including any need for an extension of time) and any other fee due to Deposit Account 10-0637.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Director of Technology Center 3600, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 this 19th day of May 2006.

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D-1056 DIV3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	McGrady, et al.)	
)	
Confirmation No.:	4092)	Art Unit 3653
)	
Application No.:	09/014,076)	
)	Patent Examiner
Filed:	January 27, 1998)	Michael E. Butler
)	
Title:	Method of Tracking and)	
	Dispensing Medical Items)	

Director of Technology Center 3600
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Kindly enter the following petitions under 37 CFR § 1.181 without prejudice.

Petition To Have The Requirement Under 37 CFR § 1.105 Withdrawn

This petition is the result of a Request for Information pursuant to 37 CFR § 1.105 ("Request") dated December 19, 2005 from Examiner Michael E. Butler. The Applicants on January 17, 2006 filed a reply ("Reply") to the Request. In their Reply, Applicants requested reconsideration and respectfully submitted that the Request was legally improper. In an Advisory Action after the filing of an Appeal Brief (dated May 3, 2006) the Reply was deemed non-responsive. Subsequent to their request for reconsideration being denied, Applicants petition to have the Request withdrawn.

The Request should be withdrawn because it is legally improper

Applicants' Reply remarks filed January 17, 2006 are herein incorporated by reference.

1. Applicants respectfully submit that the Request is legally improper because prosecution is closed. The time of the Request does not fall within the legal time period for making such a request for information. Until prosecution in the application is first reopened, the Request cannot be made.

The MPEP states that "a request for information should not be made with or after a final rejection" (§ 704.11(b)); that "actions in which requirements for information necessary for examination are made should . . . be a non-final action because the applicant's reply must be considered and applied as appropriate" (§ 704.11(b) III); and where "information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may not make the next Office action relying on that [information] . . . final" (§ 704.14(d)).

In other words, an Applicant in response to a Request has an unhindered right to consideration and entry of their Reply (MPEP § 704.14(b)), "in the same manner as an amendment . . . to a non-final Office action" (MPEP § 704.12(c)). The record shows that the Request was improperly made while prosecution was closed. As evidenced by the Examiner's use of the Advisory Action (which use requires prosecution to be closed), Applicants' were denied unhindered entry of their Reply. Nor was Applicants' Reply entered, as indicated in the Advisory Action. The Examiner cannot continue examination via the Request after prosecution has been closed. Thus, because the Request was made while prosecution was closed, Applicants' rights have been denied by the Office.

2. Applicants respectfully submit that the Request is legally improper because the information requested is not reasonably necessary to properly examine or treat a matter in the application. The information requested in the Request does not meet the legal criteria for requestable information pursuant to 37 CFR § 1.105. For example, the Request does not relate to prior art.

All of the requested information pertains to the 37 CFR § 1.131 declaration filed August 30, 2000 ("declaration"). However, no additional information is needed by the Examiner in order to make a decision on the sufficiency of the declaration. Conversely, as evidenced by the record, the declaration was already fully considered and determined sufficient by the Examiner (without the requested information). Furthermore, a decision regarding sufficiency of a 37 CFR § 1.131 declaration is made based on the facts at hand (e.g., MPEP § 715, 715.08). No additional information can change the fixed evidence already set forth in the declaration. That is, the Examiner needs no additional information to determine whether the declaration remains sufficient. Thus, the prerequisite conditions did not exist for the Office to initiate the Request. The Request is unreasonable as it has no value or merit regarding the declaration or examination.

3. Applicants respectfully submit that the Request is legally improper because there is no evidence of Office policy for making the Request. Conversely, if every Examiner alleged a need for additional information in order to decide the effectiveness of a swear behind declaration, then the Office would be overburdened with a flood of unnecessary information. From an administrative view, a denial of Applicants' petition would set unwanted legal precedent in the Office. Again, the Request is not necessary.

Petition To Have The Holding Of Non-Responsive Withdrawn

If the aforementioned petition regarding the legality of the Request is denied, then Applicants further petition that the Examiner's holding of their Reply to the Request (filed January 17, 2006) as being non-responsive is legally improper. Thus, the non-responsive holding should be withdrawn.

Applicants respectfully submit that the holding of their Reply as non-responsive is legally improper because they provided a statement that fully responded to the Request. Specifically, the Reply (at page 4, lines 1-2) included a statement therein that "The information requested to be submitted is unknown and/or is not readily available to the party or parties from which it was requested."

"A complete reply to a 37 CFR 1.105 requirement is a reply to each enumerated requirement for information giving either the information required or a statement that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested" (MPEP § 704.12(b)). Therefore, Applicants Reply constituted a complete reply. Thus, the Reply was not non-responsive, and the holding otherwise is improper.

Applicants further respectfully submit that even if the Reply was non-responsive, they were entitled to a time period of at least one month to provide additional response, in accordance with MPEP § 704.12(c). However, no time was given to Applicants. Thus, the non-responsive holding is again legally improper.

Petition For Additional Time To Respond

If the aforementioned petition regarding the holding of the Reply as non-responsive is denied, then Applicants further petition that they be granted additional time to respond because the Office improperly delayed the mailing of the Advisory Action dated May 3, 2006.

This application was filed January 27, 1998. This application has been pending more than eight (8) years and has an effective pendency more than thirteen (13) years. In accordance with MPEP § 708.01 (I) and § 707.02 this application was to be treated as a "special" case and be advanced out of turn by the Office. This application was to have been given a very high priority by the Examiner in the order of examination (MPEP § 708) and its priority handling was to have been personally overseen by the supervisory patent examiner (SPE) (MPEP § 707.02).

Applicants' Reply to the Request was filed January 17, 2006. The Office did not respond to the Reply until almost four months later (May 3, 2006) via the Advisory Action. Thus, the Office did not follow its own rules. Further, as the Office keeps meticulous tracking of the status of each application, it appears that the Office purposely delayed acting on Applicants' Reply. Applicants are not responsible for the improper and/or illegal activity of the Office. Thus, if necessary, then Applicants petition that they be given additional time to respond.

Application Status

This application is currently under appeal to the Board of Patent Appeals and Interferences ("Board"). The Appeal Brief was filed more than five (5) years ago (on March 7, 2001). The record shows that the Examiner has already fully performed his duties with regard to the declaration. Applicants respectfully request that this application be returned to the Board for prompt decision on appeal.

Conclusion

Applicants petition that the Request for Information pursuant to 37 CFR § 1.105 (set forth in the Office Action dated December 19, 2005) be withdrawn because it is legally improper.


Applicants' petition should be granted for the reasons presented herein.

Should the petition regarding the legality of the Request be denied, then Applicants further petition that the Examiner's holding of their Reply to the Request (filed January 17, 2006) as being non-responsive be withdrawn because it is legally improper. If necessary, the Applicants further petition for additional time to respond due to improper Office delay.

If further request for reconsideration is required, then Applicants respectfully request further reconsideration by the Examiner.

The undersigned is willing to discuss any aspect of the petition by telephone at the Office's convenience.

Respectfully submitted,



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